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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEAN-LOUIS H. GUERET

Appeal 2009-005633
Application 10/060,234
Technology Center 3700

Oral Hearing Held: December 9, 2009

Before WILLIAM F. PATE, III, MICHAEL W. O'NEILL, and
KEN B. BARRETT, *Administrative Patent Judges*.

ON BEHALF OF THE APPELLANT:

JEREMY T. THISSELL, ESQUIRE
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34 The above-entitled matter came on for hearing on Wednesday,
35 December 9, 2009, commencing at 9:49 a.m., at the U.S. Patent and
36 Trademark Office, 600 Dulany Street, Alexandria, Virginia, before
37 Victor Lindsay, a Notary Public.

PROCEEDINGS

THE USHER: Calendar No. 25, Mr. Thissell.

JUDGE PATE: Good morning, Mr. Thissell. We've had a chance to look at this case beforehand. I think we're up to speed on the technology and we'd like to hear your arguments about that.

MR. THISSELL: Would you like a business card.

JUDGE PATE: Please.

9 MR. THISSELL: I've never tried this before, but I have the
10 prosecution history on my laptop, so if that helps everyone as far as --

11 JUDGE PATE: We have electronic files up here, and that means we
12 can find anything while you're talking.

MR. THISSELL: That's why I say I'm going to try this.

JUDGE PATE: When you're ready, you can go ahead.

15 MR. THISSELL: Okay, is the reporter ready? Thank you for the
16 opportunity to speak this morning. My name is Jeremy Thissell on behalf of
17 Appellant. This Application is an applicator device for cosmetics or
18 medicine, antiseptics, that type of thing. And what the Applicant was
19 attempting to do was to improve upon the technology that is out there in
20 terms of what's known as sachets which are little packets that have either
21 some sort of ointment, medicine, in them, some of them have wipes that
22 have medication in them. What the Applicant was finding that these
23 products were not always the best solution for what they were looking to
24 provide their customers with. In some cases, if you have some sort of
25 cosmetic in a packet, you're not always near a restroom where you have
26 access to wash your hands, so it can be kind of messy. Similarly, if you

1 have a packet with a wipe in it, medicated wipe or a cosmetic on the wipe,
2 that can also get all over your hands. So the Applicant was really trying to
3 develop something that was small, portable, that can be used to apply the
4 product without getting all over your hands, but yet still not having to carry
5 around a big container that the product might otherwise come in.

6 And so we find ourselves with the Examiner rejecting this Application
7 and the primary reference is Gray which is a sachet. And Gray is a
8 relatively simple device, it's the sachet with the vacuum-sealed sponge
9 inside, and it has a little -- it has a product inside with it and a V-notch in the
10 sachet itself to allow you to open the packet. You tear off the end much like
11 a ketchup sachet and pull the sponge out. And the Examiner's modifying
12 this Gray reference or suggesting to modify the reference with Hitchcock
13 reference. Now, there's quite a bit of difference between the Gray reference
14 and the Hitchcock reference. The Gray reference discusses the need for a
15 wipe which will not harbor bacteria. It's suggested for hand washing prior to
16 surgery, and you can -- images come to mind of surgeons before surgery
17 standing over the sink. They pull a sponge out and they're scrubbing their
18 hands using the sponge in all different ways, all different sides.

19 Hitchcock discloses a product that doesn't seem to indicate anything
20 about the sterility of this handle. It has a handle with a sponge attached to it
21 with a -- some sort of a film that covers the sponge, a peel-off film, now you
22 have an applicator with a handle on it. Hitchcock discusses using this type
23 of product, for example, for swabbing injection sites for a vaccination, for
24 example.

25 So right off the bat we see some differences between the two
26 references. Gray is very concerned with having a sponge that's -- you

1 doesn't, doesn't harbor bacteria, it's sterile. Whereas, Hitchcock is more
2 concerned -- is not necessarily as concerned with having this overall product
3 that's going to be used to be sterile, it has a handle. You hold on to it, you
4 swab the skin quickly, and you're done. Another thing that -- another
5 contrast between these two references is that Gray, as I mentioned, discusses
6 a vacuum seal and one of the reasons Gray proposes this is to shrink the size
7 of the package. He mentions shrinking the size of the package by one half.
8 That makes it -- for improvements in storage and portability, packaging for
9 maybe sterilization kits, that type of thing. Hitchcock, on the other hand,
10 discusses a rigid backing which is used ultimately as the handle, but you
11 could see if you have this rigid backing, it's not going to shrink the overall
12 product by half, probably not hardly at all. So, for at least those reasons, we
13 could see that the Examiner suggests attaching this, this sponge in Gray to
14 the sachet based on the teachings of Hitchcock of attaching a sponge to some
15 sort of handle or rigid backing.

16 The Appellant does not believe it's obvious to modify Gray in this
17 way because of these differences. For one, one of the features of this Gray
18 reference is this V-notch, and if you attach the sponge of Gray to the sachet,
19 then the V-notch doesn't work anymore. You can get the package open, but
20 you can no longer get the sponge out. And furthermore, even if you could
21 get the packet open somehow and expose the sponge, this is really a step
22 backwards in terms of the Gray reference because as the Gray reference is
23 presented, it has, you know, the packet, you rip it open, you pull the sponge
24 out, you can use all different sides of. It's quick, it's easy, and it's very
25 simple, very simple to make. Whereas, if you attach the sponge of Gray,
26 now you've got something that's cumbersome, you've got this sort of film

1 backing on the side of the sponge. You've now eliminated almost a third of
2 the surface area of the sponge because you've attached it to a --

3 JUDGE BARRETT: Counsel, is this Argument in your Brief?

4 MR. THISSELL: Well, we're -- our Argument in the Brief discusses
5 the, the V-notch no longer works. And -- well, this Argument's in the Brief,
6 you know, to the extent that we're suggesting that there's just differences
7 between these two that are not -- would not have led one of ordinary skill to
8 modify the reference in this way.

9 JUDGE BARRETT: Concerning the V-notch argument, how do you
10 respond to the Examiner's position that one of ordinary skill in the art would
11 have recognized there's other ways to open the package that would have
12 been obvious to do so in light of the secondary reference's teachings where
13 they peel apart?

14 MR. THISSELL: Well, I think the Examiner's proposing to change so
15 much about the Gray reference that by the time he's done, he's got a different
16 product altogether. For example, the Gray reference is a relatively simple
17 device as I mentioned. It has really five main features, it has a top film,
18 bottom film, a sponge that's not attached to the film in any particular way,
19 that's three, there's a vacuum seal, and there's this V-notch. Well, first of all,
20 the Appellant believes that it's not -- if you're going to modify the, the Gray
21 reference to attach the sponge, it doesn't make any sense to attach the sponge
22 without having some sort of a rigid backing because the, the sachet of Gray
23 is just flexible and it doesn't really serve as a good handle. So in order to do
24 that, you'd have, you'd have to modify the bottom film, you'd have to now
25 attach the sponge, that's two differences, and then the third is the Examiner's
26 suggesting to use an alternative means of opening the packet instead of the

1 V-notch. So out of the five main features of the Gray reference, the
2 Examiner is suggesting to change three of them. And it's not, it's not just
3 adding features to the Gray reference, it's changing, it's changing the
4 principle of operation of the reference.

5 JUDGE O'NEILL: Are you arguing that changing the principle of
6 your operation, the primary reference would, in effect, render the primary
7 reference inoperable for its intended use?

8 MR. THISSELL: In some ways, yes, but, but not necessarily with all
9 the features. For example, if you're going to modify the V-notch -- excuse
10 me, if you were to attach the sponge, that would render the primary
11 reference no longer capable of, of use in its intended manner because, as I
12 mentioned, you can no longer get the sponge out. You tear off the end of the
13 sachet, the sponge is still stuck inside. So in that way, yes, it would, it
14 would render it no longer capable of its intended use.

15 JUDGE BARRETT: In the Brief, isn't it suggested that once you rip
16 the V-notch open you have to effectively lay open the package then to
17 expose the sponge? And I believe your argument was that that would make
18 -- that would destroy the intended purpose, and I, I fail to see why that
19 would destroy the purpose.

20 MR. THISSELL: Well, the purpose of the V-notch is to make
21 opening the package quick and easy. You tear off the end, you pull out the
22 sponge, and that's the end of it. If the purpose -- if the idea is to peel the two
23 layers apart, then the V-notch is, is not the appropriate mechanism for doing
24 that. It would make much more sense to have some sort of a separation
25 between the two in a corner, for example, but that wasn't the intended use of
26 this product. As I said, the Gray reference is a very simple product, very

1 simple device, and they just wanted a packet, you tear off the end, you pull
2 out the sponge. And you can't get to -- from Gray to the Appellant's claims
3 without changing two, three, four things about the Gray reference. And not
4 just improving it, not just adding a feature, not just, you know, making it
5 adjustable on some way, but changing it, changing the V-notch to some
6 other way of opening it, changing the device from having a, a free, separate
7 sponge to having a sponge that's attached to the backing in some way.
8 Taking the backing that's a film and making it some sort of a rigid backing,
9 and by the time you're done doing that, you have a completely different
10 device.

11 JUDGE O'NEILL: So your argument seems to be focused on the
12 combinability of the two references, but not necessarily that there is missing
13 the two -- that there are -- are there limitations missing from within the
14 two references, or do you have like -- in your claims is there a missing
15 limitation? In other words, is there a difference between the content of the
16 combination of the prior art and your claimed invention? Or, or is your
17 main argument that you just wouldn't take the teachings from the secondary
18 reference and apply them to the primary reference because you'd be
19 modifying five different -- three to five different structural features of the
20 primary reference?

21 MR. THISSELL: I think it's -- it depends a little bit on how you look
22 at it, but the, the core of the Argument is that the claims require that the
23 sponge -- the applicator is attached to one portion. And in the Gray
24 reference, you have two flexible portions, and in Hitchcock you have a
25 backing, a rigid backing of some sort, and the sponge attached to the
26 backing. So there's no teaching or suggestion, I guess, of making a sachet

1 like Gray with an attached sponge. It's probably more on the side of there
2 being no motivation or suggestion to combine the references.

3 JUDGE O'NEILL: But that's not an issue anymore, it's what -- the
4 issue is does the combination of -- render obvious the claimed invention.
5 That's what I'm having difficulty with. I've read the Examiner's position and
6 it seems the Examiner has identified all the limitations of the claims and that
7 they're in two different references. And he provides -- and the Examiner
8 provides a, a reason and it seems that the reason has some rational
9 underpinning. So to my mind, I need to know whether, well, the -- one
10 reference, the teaching reference actually if you did apply it, it would teach
11 away or, or if there's some sort of other, other indicia of non-obviousness
12 going on. And that's what I'm trying to figure out here, or there is a
13 limitation missing.

14 MR. THISSELL: I think it's not so much that there's a limitation
15 missing. I think that the -- I think to answer your question, it's more the case
16 that we believe it would not have been obvious to combine the references to
17 achieve the claimed invention,

18 JUDGE O'NEILL: Why?

19 MR. THISSELL: Well, for one, you asked for something, some sort
20 of teaching away. It's not exactly teaching away, but if, as I mentioned, if
21 you were to take the -- this teaching of attachment by Hitchcock and then
22 apply it to Gray and modify Gray in that way, then the V-notch mechanism
23 for opening the product no longer works. So that's a reason why you would
24 not have modified it in that way.

25 JUDGE O'NEILL: Okay, so we have -- but the Examiner countered
26 that and said well, it's well-known to have different types of, of mechanisms

1 of opening these little sachets, for instance -- a part of the Examiner's -- and,
2 in fact, the Hitchcock reference shows it being peeled apart. So we do have
3 some evidence that one of ordinary skill in the art would know another way
4 of opening what would be another --

5 MR. THISSELL: So, if you modify Gray in that way, you now no
6 longer have two films with a unattached sponge. You now have attached
7 sponge, no V-notch, you have some sort of different peeling detachment
8 mechanism. The Applicant believes that in order to do that, the only way
9 that would make sense according to what's shown in these references in
10 order to attach the applicator to the base, as far as these references are
11 concerned, it only makes sense to do that if the backing is rigid. And so now
12 what you're left with is a device that looks like Hitchcock, not like Gray.
13 You don't have Gray anymore, you have Hitchcock. You have a device with
14 a rigid backing, attached sponge, and a peeling mechanism for opening it
15 instead of a V-notch. It's a completely different device. Yes, it's used for
16 applying medicine, yes, it could be used for cosmetic possibly, but it's -- you
17 end up with something completely different.

18 JUDGE O'NEILL: So I think I'm now hearing that you're having
19 problems with the Examiner's rejection and the manner of the way that the
20 Examiner has presented which reference as being modified with which. So
21 if we took it the other way around and said well, we'll modify Hitchcock
22 with the teachings of Gray in order to reach the claimed invention, what is
23 the problem?

24 MR. THISSELL: Well, for one, Hitchcock reference doesn't disclose
25 the sponge as compressed, at least partially, when it's packaged together.

1 JUDGE O'NEILL: That's what the Gray reference would now
2 disclose, correct? The sponge is compressed at least partially?

3 MR. THISSELL: Right. So -- but as I mentioned, the Gray reference
4 is, is designed to shrink the product to half it's original size for a number of
5 reasons. But as I said, if you were to try the same thing with Hitchcock, you
6 could get almost no shrinkage because it's got a rigid backing to it.

7 JUDGE PATE: Any more questions?

8 Well, I have no more questions for you either, and so we're going to
9 take this case under advisement. Thank you very much.

10 MR. THISSELL: Thank you.

11 (Whereupon, the proceedings, at 10:13 a.m., were concluded.)